

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
 Jared J. Jackson)
)
 Application No.: 09/812,872)
 Confirmation No.: 1256)
 Group Art Unit: 2155)
 Filed: March 19, 2001)
 Examiner: ASAD M NAWAZ)
 For: *SYSTEM AND METHOD FOR*)
ADAPTIVE FORMATTING OF IMAGE)
INFORMATION FOR EFFICIENT)
DELIVERY AND PRESENTATION)
 _____)

APPEAL BRIEF

MS-APPEAL BRIEF-PATENTS
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to a Final Office Action dated May 4, 2007, followed by a Notice of Appeal with Pre-Appeal Conference Request Brief filed September 4, 2007, and a Notice of Disagreement and Invitation to file Appeal Brief dated September 27, 2007. A Petition for extension of time to timely file this Appeal Brief is also filed herewith. Reconsideration of the Application, withdrawal of the rejections, and allowance of the claims are respectfully requested.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically sent to:
 Mail Stop Appeal Brief-Patent, Commissioner for Patents, on the date shown below.

ON: December 4, 2007 BY: Karen Taragowski

SIGNATURE: /Karen Taragowski/

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines (IBM) of Armonk, NY.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-22 are pending.

Claims 1 through 22 are rejected.

The Appellant is appealing the rejection of independent claims 1-3, 7, 9, 11, and 13 (and all other remaining claims that depend from these claims). Claims 1-3, 7, 9, 11, and 13 are on appeal.

IV. STATUS OF AMENDMENTS

The Examiner issued a final rejection of claims 1-22 in the Final Office Action of May 4, 2007. Appellants submitted a Notice of Appeal with Pre-Appeal Conference Request Brief filed September 4, 2007 in response to the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

This summary references line numbers of the specification as filed. It is to be noted that the text of each page of the filed specification starts with line number 5.

The pending independent claims under appeal in this case are corresponding method, computer readable medium, and apparatus claims. The following identifies the subject matter defined in each of the claims under appeal in the present application.

Independent method Claim 1 sets forth the following subject matter.

A) receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server.: Abstract; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

B) the session information being separate from the request for delivery of image information: FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

C) determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device,) an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device.: Abstract; FIG. 6; FIG. 8; FIG. 9; page 15, lines 18-20; and page 21, lines 17-20 to page 22, lines 1-12.

D) the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and: FIG. 3, showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); page 14, line 18 to page 15, line 5; page 15, lines 18-20 to page 16, lines 1-3; page 21, lines 17-20 to page 22, lines 1-12; and page 27, line 15 through page 28, line 10.

E) providing a response for the request, the response comprising at least a portion of the image information in the image format.: Abstract; and page 16, lines 11-20 to page 17, lines 1-12.

Independent computer readable medium claim 2 sets forth the following subject matter.

A) receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server.: Abstract; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

B) the session information being separate from the request for delivery of image information.: FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

C) determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device.: Abstract; FIG. 6; FIG. 8; FIG. 9; page 15, lines 18-20; and page 21, lines 17-20 to page 22, lines 1-12.

D) the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and: FIG. 3, showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); page 14, line 18 to page 15, line 5; page 15, lines 18-20 to page 16, lines 1-3; page 21, lines 17-20 to page 22, lines 1-12; and page 27, line 15 through page 28, line 10.

E) providing a response for the request, the response comprising at least a portion of the image information in the image format: Abstract; and page 16, lines 11-20 to page 17, lines 1-12.

Independent apparatus claim 3 sets forth the following subject matter.

A) a first memory for storing at least one of an image delivery parameter and an image presentation parameter associated with a networked device;: FIG. 2; FIG. 3; page 7, lines 8-10; and page 32, lines 1-20 to page 33, and lines 1-8.

B) a network interface for communicating with a network:: FIG. 2; FIG. 3; page 7, lines 10-11; page 19, line 16; page 21, lines 2-3; and page 23, lines 5-6 and lines 11-13.

C) a controller, communicatively coupled to the first memory and to the network interface; and: FIG. 2; FIG. 3; and page 7, lines 10-12.

D) a second memory, communicatively coupled to the controller, for storing computer instructions for the controller to control the content server system to::FIG. 2; FIG. 3; and page 7, lines 12-13.

E) receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server: Abstract; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for

parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

F) the session information being separate from the request for delivery of image information;: FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

G) determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device;: Abstract; FIG. 6; FIG. 8; FIG. 9; page 15, lines 18-20; and page 21, lines 17-20 to page 22, lines 1-12.

H) the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and: FIG. 3, showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); page 14, line 18 to page 15, line 5; page 15, lines 18-20 to page 16, lines 1-3; page 21, lines 17-20 to page 22, lines 1-12; and page 27, line 15 through page 28, line 10.

I) providing a response for the request, the response comprising at least a portion of the image information in the image format. Abstract; and page 16, lines 11-20 to page 17, lines 1-12.

Independent method claim 7 sets forth the following subject matter.

A) receiving a request that includes a request for delivery of image information to a networked client device and session information pertaining to the current communication session between the networked device and a server.; Abstract; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

B) the session information being separate from the request for delivery of image information; and; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10..

C) determining, by at least one server within a network, an image format for the image information from an image delivery parameter and an image presentation parameter associated with the networked client device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.; Abstract; FIG. 6; FIG. 8; FIG. 9; page 15, lines 18-20; and page 21, lines 17-20 to page 22, lines 1-12.

Independent computer readable medium claim 9 sets forth the following subject matter.

A) receiving a request that includes a request for delivery of image information to a networked client device and session information pertaining to the current communication session between the networked device and a server.; Abstract; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and

338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

B) the session information being separate from the request for delivery of image information; and: FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

C) determining, by at least one server within a network, an image format for the image information from an image delivery parameter and an image presentation parameter associated with the networked client device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.: Abstract; FIG. 6; FIG. 8; FIG. 9; page 15, lines 18-20; and page 21, lines 17-20 to page 22, lines 1-12.

Independent method Claim 11 sets forth the following subject matter.

A) storing an image delivery parameter and an image presentation parameter associated with a networked device; : FIG. 2; FIG. 3; FIG. 5; FIG. 9; and page 7, lines 7-10.

B) receiving a request that includes a request for delivery of displayable image information to the networked device and session information pertaining to a current communication session between the networked device and a server.: Abstract; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

C) the session information being separate from the request for delivery of, the displayable image information;: FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

D) determining, by at least one server within a network, available image formats for the displayable image information; and: Abstract; FIG. 6; FIG. 8; FIG. 9; page 15, lines 18-20; and page 21, lines 17-20 to page 22, lines 1-12.

E) selecting one of the available image formats, based at least in part on the image delivery parameter and the image presentation parameter, for delivery to and presentation at the networked device.: FIG. 6; and page 25, lines 10-11.

F) the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.: FIG. 3, showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); page 14, line 18 to page 15, line 5; page 15, lines 18-20 to page 16, lines 1-3; page 21, lines 17-20 to page 22, lines 1-12; and page 27, line 15 through page 28, line 10.

Independent apparatus Claim 13 sets forth the following subject matter.

A) at least one networked device; and: FIG. 2; FIG. 3; page 6, lines 18-19; page 7, lines 9-10; and page 12, lines 17-19.

B) a content server for delivering content information comprising image information to the at least one networked device, the content server including:: FIG. 2; FIG. 3; page 17, lines 15-18; and page 19, lines 16-20 to page 20, lines 1-18.

C) a first memory for storing an image delivery parameter and an image presentation parameter associated with a networked device:: FIG. 2; FIG. 3; page 7, lines 7-10.

D) a network interface for communicating with a network link communicatively coupled with the at least one networked device:: FIG. 2; FIG. 3; page 7, lines 10-11; and page 19, line 16.

E) a controller, communicatively coupled to the first memory and to the network interface; and: FIG. 2; FIG. 3; and page 7, lines 10-12.

F) a second memory, communicatively coupled to the controller, for storing computer instructions for the controller to control the content server for:: FIG. 2; FIG. 3; and page 7, lines 12-13.

G) receiving a request that includes a request for delivery of content information to the at least one networked device and session information pertaining to a current communication session between the networked device and a server,:: Abstract; FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5;

page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

H) the session information being separate from the request for delivery of the content information comprising image information; and: FIG. 3 showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); FIG. 7; page 6, lines 15-20 to page 7, lines 1-3; page 14, lines 14-20 to page 15, lines 1-5; page 21, lines 17-20 to page 22, line 5; page 23, line 14, to page 24, line 2; and page 27, line 15 to page 28, line 10.

I) determining, by at least one server within a network, based on the image delivery parameter and the image presentation parameter associated with the at least one networked device, an image format for the image information for delivery of the image information to the at least one networked device and for presentation of the image information at the at least one networked device,: Abstract; FIG. 6; FIG. 8; FIG. 9; page 15, lines 18-20; and page 21, lines 17-20 to page 22, lines 1-12.

J) the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information,: FIG. 3, showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); page 14, line 18 to page 15, line 5; page 15, lines 18-20 to page 16, lines 1-3; page 21, lines 17-20 to page 22, lines 1-12; and page 27, line 15 through page 28, line 10.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-3, 7, 9, 11, and 13 are unpatentable under 35 U.S.C. §103(a) over *Lee et al.* (U. S. Patent No. 6,779,040) in view of *Holtz et al.* (U.S. Patent Publication No. 20020053078).

VII. ARGUMENT

A. WHETHER CLAIMS 1-3, 7, 9, 11, and 13 ARE UNPATENTABLE OVER LEE IN VIEW OF HOLTZ

In the Examiner's Office Action of August 22, 2006, the Examiner rejected claims 1-15 and 19-22 under 35 U.S.C. §103(a) as being unpatentable under 35 U.S.C. §103(a) over *Lee et al.* (U. S. Patent No. 6,779,040) in view of *Holtz et al.* (U.S. Patent Publication No. 20020053078). The Appellant respectfully submits that claims 1-15 and 19-22 are patentable over *Lee* and/or *Holtz* under 35 U.S.C. § 103(a). The Appellant asserts that neither the *Lee* or *Holtz* references, taken either alone or in combination with one another, teach or suggest the claimed limitations.

The Appellant respectfully suggests selection of independent Claim 1 as representative of the independent claims on appeal. Independent Claim 1 is directed towards a method comprising:

receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information;

determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and

providing a response for the request, the response comprising at least a portion of the image information in the image format.

The Appellant asserts that, in particular, the underlined portions of the above claims are not taught or suggested by the *Lee* and/or *Holtz* references, taken either individually or in combination with one another.

The claims were rejected under 35 U.S.C. §103(a). The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter “as a whole,” and the key to proper determination of the differences between the prior art and the presently claimed invention is giving full recognition to the invention “as a whole.” As discussed below, the Appellant asserts that these limitations, especially when considered in the context of the other limitations of Claim 1, are not described in the prior art references of record and that these limitations render the claimed subject matter non-obvious over the prior art.

The presently claimed invention is advantageous over the prior art for many reasons. For example, the presently claimed invention determines image delivery parameters and image presentation parameters (session information) and passes this information along with requests for media from a web content server. Instant specification, pages 21-22. The session information contains the image delivery parameters and the image presentation parameters, and is separate from an image delivery request. The presently claimed invention is thereby able to react to changes in network connections or conditions and to changes in device capabilities by tailoring the media to the image delivery parameter and the image presentation parameter that is associated with each image delivery request.

Overview of Prior Art

The *Lee* reference is directed towards on-demand data compression of data files for transfer from a server computer to a client computer. *Lee*, col. 2, lines 62-63. *Lee* discloses two types of requests: 1) a request for an image; and 2) a request to register a set of client computer capabilities and user preferences to be used for future image

requests. A user may register various user preferences and user computer capabilities with the server computer prior to requesting the data file, or may indicate some or all of the preferences and capabilities at the time of the request for the data file. *Lee*, col. 2, line 64 through col. 3, line 1. Importantly, the preferences and capabilities are known only after a user registers them. “An example of an indicated parameter might, for example, be a parameter indicating the bandwidth of the client computer's interconnection with the Internet”. *Lee*, col. 12, lines 59-62.

The server computer then compresses the requested data file according to the capabilities of the user's computer and user preferences. *Lee*, col. 3, lines 1-4. *Lee* col. 12, lines 14-48. In other words, *Lee* adjusts the size of data files sent to a client computer based only on parameters of the client device and client preferences that are sent to the *Lee* system by the client. *Lee* is silent on how the client device provides parameters, and specifically, how the user-specified rules for data transmission capabilities are communicated. Regardless, the information conveyed in *Lee* is always within a request to register client computer capabilities and user preference parameters. See *Lee et al.* col. 11, lines 41-47 and col. 12, line 14-48. ***Lee* is silent on session information.**

The *Holtz* reference is directed towards a multimedia production and distribution system where a client can select various options to customize the transmission of content from the server to the client. *Holtz* Abstract. As is shown in FIG. 15 of *Holtz*, when a user wishes to customize the transmission, he requests an enhanced media viewer, which is sent from the server to the requesting client. *Holtz*, paragraph [0114]. Only after the client receives the viewer can he then receive enhanced media segments. *Holtz*, paragraph [0118], and FIG. 16. These segments can be displayed on the viewer. *Holtz*, FIG. 16. Importantly, a client using the *Holtz* invention determines the display preferences at a particular time and then all requests for media after that time are sent in conformance with the request and are viewable on the media player that was previously sent from the server to the client. *Holtz*, paragraph [0027]. ***Holtz* is silent on session information.**

Cited References Fail to Describe All Limitations

As correctly recognized by the Examiner on page 4 of the above-identified Office Action, “*Lee et al.* does not explicitly indicate the request including a session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information and the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.” The Examiner goes on to combine *Holtz et al.*

In order to establish a prima facie case of obviousness by modifying or combining reference teachings, MPEP § 2143 requires that:

- there must be some suggestion or motivation to combine the references in the prior art;
- there must be a reasonable expectation of success to be found in the prior art; and
- the prior art references must teach or suggest all the claim limitations.

It is believed that not one of the three criteria has been met.

To begin, the *Holtz* reference is only directed towards a multimedia production and distribution system where a client can select various options to customize the transmission from the server to the client. *Holtz Abstract*. *Holtz* is not concerned with current device or network conditions and/or capabilities, as is the present invention. *Holtz* does not send “parameters,” but instead sends requests for file formats (e.g. WMV format, MPEG format, etc.). If a user using the *Holtz* invention made a request for media in a particular format and subsequently, network conditions or connection type

changed, the *Holtz* invention would not respond to accommodate those changes, as would the present invention. In other words, *Holtz* is not concerned with parameters. *Holtz* is also silent regarding session information.

Furthermore, *Holtz* is able to request transmission types, such as downloaded, streamed, or saved to the client. *Holtz*, paragraph [0026]. However, these requests are not made by transmitting session information, image delivery parameters, or image presentation parameters, but are instead made by specifically requesting a particular transmission method. In fact, *Holtz* is completely silent “receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information”.

A reading of *Holtz* reveals that *Holtz* is not concerned with receiving session information pertaining to a current communication session between the networked device and a server that is separate from an image information delivery request, where the session information includes image delivery parameters and the image presentation parameters. For example, *Holtz* explicitly teaches that “media streams [are] formatted to support multimedia applications available from “RealNetworks, Inc. (Seattle, Wash.), Microsoft Corporation (Redmond, Wash.), and Apple Computer, Inc. (Cupertino, Calif.), or like applications as would be apparent to one skilled in the relevant art(s). In addition to the aforementioned proprietary formats, the media stream formats can include, but are not limited to, MPEG-2 and MPEG-4 non-proprietary formats.” *Holtz* at paragraph [0062]. Also, *Holtz* teaches that a viewer on the media client allows a user to build a show. Once a user builds the show the media client receives an ASX metafile for playing multiple WMV files.

As can be seen, the content in *Holtz* is already pre-formatted based on a pre-selected application. Stated differently, the content on the enhanced media server of

Holtz is already formatted prior to receiving a request from a client device. Customization as referred to by *Holtz* merely allows a user to select the content (e.g. video segments) that is to be sent to his/her device. See *Holtz* at paragraphs [0085-0086] and [0203-0211]. Nowhere does *Holtz* teach or suggest “receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information”.

Furthermore, the Examiner appears to be reading in the claims that the image delivery and image presentation parameters are separate from the session information. This reading is unsupported by a plain reading of the claim language, by the teachings in the specification, and by Applicant's arguments in the responses to the Office Actions, and consequently this reading constitutes **clear error** on the part of the Examiner. Additionally, the prior art, as discussed above, does not teach or suggest, as presently claimed, that the image delivery parameter and image presentation parameter are contained in the session information. The Examiner therefore has failed to make a prima facie obviousness rejection under 35 USC 103.

For example, the Examiner, in the present Final Office Action, dated May 4, 2007, on page 9, lines 8-12, states, in response to arguments asserted, the following.

In response C) the Examiner points out that **although the applicant argues that the image presentation parameters are session information, they are written as separate entities in the claims. Thus, they are given their broadest reasonable interpretation.** Therefore, *Lee* in view of *Holtz* still meets the scope of the limitations as currently claimed. **(Emphasis added.)**

The Examiner, in the present Final Office Action, on page 4, lines 6-10, specifically cited to *Holtz*, U.S. Patent Publication No. 20020053078A1, as teaching that

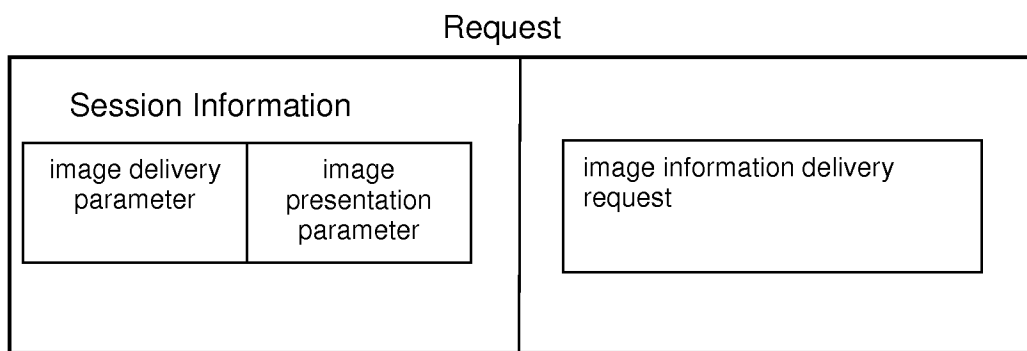
the image delivery parameter and the image presentation parameter associated with the networked device **being contained in** the session information (with reference to the Abstract in *Holtz*). This is clear error by the Examiner.

The Appellant traverses the Examiner's finding that the claim language can reasonably be interpreted to mean that the image delivery and presentation parameters **are separate entities from the session information**. This interpretation is contrary to a plain reading of the claim language, the definition taught in the specification, and Appellant's arguments made on the record in response to Office Actions.

Claim 1 explicitly states "the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information"

The normal dictionary meaning of the term "being contained in" is "**being comprised in**". This, in the context of Claim 1, means that the image delivery parameter and the image presentation parameter are comprised in the session information.

The diagram below illustrates the above claim element.



As can be seen from the above diagram, the image delivery parameter and the image presentation parameter associated with the networked device are contained in the

session information and **are not** separate from the session information nor does Claim 1 recite such separation as alleged by the Examiner.

It is understood from the teachings in the specification and drawings of the application that the image-delivery parameter and the image presentation parameter **are part of** the session information pertaining to a current communication session between the networked device and a server, the session information being separate from a request for delivery of image information by the networked device.

Teachings found in the originally filed specification and drawings support the presently claimed “*the image delivery parameter and the image presentation parameter associated with the networked device **being contained in** the session information.*”

For example, see the specification of the instant application, from page 14, line 18 through page 15, line 5. See also page 21, line 18, to page 22, line 5; and also page 27, line 15 through page 28, line 10.

Additionally, see FIG. 3, showing the image delivery parameters 330 and image presentation parameters 332 (and see also 336 and 338 for parameters specific to the second record 336 in the data base); and with reference to FIG. 3, also see the specification, from page 23, line 14, to page 24, line 2.

The Appellant has additionally confirmed on the record that the image delivery and presentation parameter are session information, as recognized by the Examiner in the pending Final Office Action, on page 9, lines 8-12. Specifically, the Examiner stated that “the applicant argues that the image presentation parameters are session information”.

Therefore, the Examiner’s assertion that the claim language recites that the image delivery and image presentation parameters **are separate** from the session information

is **clear error** and is unsupported by a plain reading of the claim language, by the teachings in the specification, and by Applicant's arguments in the responses to the Office Actions.

Additionally, the Appellant asserts that Claim 1 is non-obvious over *Lee* in view of *Holtz* notwithstanding the Examiner's assertions in the Final Office Action. The Examiner states on page 4 of the final Office Action that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings *Holtz* into those of *Lee* in order to make the system more secure. Keeping information such as session information allows for the parties involved to communicated (*Sic*) in a longer session that has been authenticated without the need to repeatedly input repetitive information". This motivation for the combination of teachings alleged by the Examiner is completely irrelevant to the subject matter of Claim 1 and to overcoming the deficiency of *Lee* for not teaching at least that "the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information".

As discussed above, *Lee* is directed towards on-demand data compression of data files for transfer from a server computer to a client computer. A user can submit two different types of requests to a server: 1) a request for an image; and 2) a request to register a set of client computer capabilities and user preferences to be used for future image requests. Importantly, **the preferences and capabilities are known only after a user registers them**. "An example of an indicated parameter might, for example, be a parameter indicating the bandwidth of the client computer's interconnection with the Internet". The server computer then compresses the requested data file according to the capabilities of the user's computer and user preferences. The information conveyed in *Lee* is always within a **request to register client computer capabilities and user preference parameters**. *Lee* is silent regarding session information.

Holtz is directed towards a multimedia production and distribution system where a client can select multiple video segments from a content sever. The content residing at the content server is already pre-formatted based on a pre-selected application. Stated differently, the content on the enhanced media server of *Holtz* is already formatted prior to receiving a request from a client device. Customization as referred to by *Holtz* merely allows a user to select the content such as video segments that are to be sent to his/her device. **Holtz is silent regarding session information.**

As can be seen, *Lee* teaches adjusting the size of data files sent to a client computer **based only on parameters of the client device and client preferences** that are **sent** to the *Lee* system **by the client**. The information conveyed in *Lee* is always within a **request to register client computer capabilities and user preference parameters**. *Holtz* teaches a system where a client can select multiple video segments from a content sever where they are pre-formatted for particular applications such as Windows Media Player. The content server then transmits these video segments to the user.

Neither *Lee*, *Holtz*, nor any combination thereof, teach or suggest “receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information”. *Lee*, at best, teaches parameters within a **request to register client computer capabilities and user preference parameters**. These parameters such as bandwidth capabilities are used to select a compression type. *Holtz* teaches that a user sends content selection information. Clearly, the presently claimed “the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information” is **not** rendered obvious from the irrelevant teachings of *Lee* and *Holtz*.

The Appellant respectfully asserts that the suggestion for these elements cannot come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The references of *Lee* and/or *Holtz* do not even mention, teach, or suggest, these claim limitations.

Accordingly, independent claims 1-3, 7, 9, 11, and 13 distinguish over *Lee* and/or *Holtz* and/or any other reference cited by the Examiner throughout prosecution history for at least the reasons stated above. Claims 4-6, 8, 10, 12, 14-15, and 19-22 depend from claims 1, 3, 7, 9, 11, and 13, respectively. Since dependent claims contain all the limitations of the independent claims, Claims 4-6, 8, 10, 12, 14-15, and 19-22 distinguish over *Lee* and/or *Holtz* as well.

B. WHETHER DEPENDENT CLAIMS 16 and 18 ARE UNPATENTABLE OVER LEE AND FIELDS IN VIEW OF SALO

Furthermore, the Examiner rejected Claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over *Lee* and *Fields* et al. in view of *Salo* et al. (U.S. Patent No. 6,563,800).

The Appellant would like to point out that the Examiner never addressed *Fields* on page 7 of the Final Office Action dated May 4, 2007, where Claims 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lee* and *Fields* et al. in view of *Salo* et al. (U.S. Patent No. 6,563,800). In fact, the Examiner only refers to *Lee*, *Holtz*, and *Salo*.

The Examiner combines *Fields* with *Lee* as a 102(e)/103(a) reference to attempt to render obvious the presently claimed invention. However, as stated in the July 12, 2006 Response Without Amendment, *Fields* and the instant application are commonly assigned to International Business Machines, Inc. 35 U.S.C. §103 (c)(1) states that “subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

An assignment from the Appellant of the instant application to International Business Machines, Inc. was filed with the Patent Office and recorded by the Patent Office on March 13, 2001 on reel 011673 and frame 0645. The commonly assigned *Fields* reference is “a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.” Therefore, the *Fields* reference cannot properly be cited against the instant application and is disqualified as a citable reference.

Furthermore, *Fields* and *Salo* are completely silent on “receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information; determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and providing a response for the request, the response comprising at least a portion of the image information in the image format”, as well.

Because, as discussed above, none of the cited references or any combination thereof teach or suggest the presently claimed invention as recited for dependent claims 16 and 18, and further because the *Fields* and *Salo* references either individually or in any combination thereof, do not disclose the elements missing from *Lee* and/or *Holtz*, and furthermore because the *Fields* reference cannot properly be cited against the instant application, it is accordingly believed to be clear that *Lee* whether taken alone or in any combination with *Holtz*, *Fields*, and *Salo*, neither shows nor suggests the features of independent Claim 13 (which recites similar to Claim1). Claim 13 is, therefore, patentable over the cited art. Dependent claims 16-18 are patentable as well because they are dependent from Claim 13. Appellant therefore submits that the rejection of Claims 16-17 under 35 U.S.C. 103(a) should be reversed.

In view of the foregoing remarks and arguments the rejection of claims 1-22 should be reversed.

CONCLUSION

For the reasons stated above, the Appellant respectfully contends that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,

Dated: December 4, 2007

By: /Jose Gutman/
Jose Gutman, Reg. No. 35,171
Attorney for Appellant

By: /Thomas Grzesik/
Thomas S. Grzesik, Reg. No. 54,139
Attorney for Appellant

Fleit, Kain, Gibbons, Gutman,
Bongini & Bianco PL
551 N.W. 77th Street, Suite 111
Boca Raton, FL 33487
Tel. (561) 989-9811
Fax (561) 989-9812

VIII. CLAIMS APPENDIX

1. A method comprising the steps of:

receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information;

determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and

providing a response for the request, the response comprising at least a portion of the image information in the image format.

2. A computer readable medium including computer instructions for an image server system, the computer instructions comprising instructions for:

receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information;

determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and

providing a response for the request, the response comprising at least a portion of the image information in the image format.

3. A content server system comprising:
- a first memory for storing at least one of an image delivery parameter and an image presentation parameter associated with a networked device;
 - a network interface for communicating with a network;
 - a controller, communicatively coupled to the first memory and to the network interface; and
 - a second memory, communicatively coupled to the controller, for storing computer instructions for the controller to control the content server system to:
 - receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information;
 - determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information; and
 - providing a response for the request, the response comprising at least a portion of the image information in the image format.

4. The content server system of claim 3, wherein the second memory includes computer instruction for the controller to control the server system to:

couple the response to the network interface, the response being destined for reception by the networked device.

5. The content server system of claim 3, wherein the second memory includes computer instruction for the controller to control the server system to:

receive, along with the request, the at least one of the image delivery parameter and the image presentation parameter associated with the networked device; and

store the at least one of the image delivery parameter and the image presentation parameter in the first memory.

6. The content server system of claim 5, wherein the program memory includes computer instruction for the controller to control the server system to:

receive the request from one of the networked device and another requester device.

7. A method comprising the steps of:

receiving a request that includes a request for delivery of image information to a networked client device and session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information; and

determining, by at least one server within a network, an image format for the image information from an image delivery parameter and an image presentation parameter associated with the networked client device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.

8. The method of claim 7, wherein the determining is performed with a proxy server that is separate and remote across the network from the server.

9. A computer readable medium including computer instructions for:
- receiving a request that includes a request for delivery of image information to a networked client device and session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information; and
- determining, by at least one server within a network an image format for the image information from an image delivery parameter and an image presentation parameter associated with the networked client device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.
10. The computer readable medium of claim 9, wherein the computer instructions further include instructions for providing a response for the request, the response comprising at least a portion of the image information in the image format.

11. A method comprising the steps of:

storing an image delivery parameter and an image presentation parameter associated with a networked device;

receiving a request that includes a request for delivery of displayable image information to the networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of, the displayable image information;

determining, by at least one server within a network, available image formats for the displayable image information; and

selecting one of the available image formats, based at least in part on the image delivery parameter and the image presentation parameter, for delivery to and presentation at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.

12. The method of Claim 11, further comprising the steps of:

building a file comprising at least a portion of the displayable image information in the selected one of the available image formats; and

sending the file to a network interface, the file being destined for reception by the networked device.

13. A system comprising:
- at least one networked device; and
 - a content server for delivering content information comprising image information to the at least one networked device, the content server including:
 - a first memory for storing an image delivery parameter and an image presentation parameter associated with a networked device;
 - a network interface for communicating with a network link communicatively coupled with the at least one networked device;
 - a controller, communicatively coupled to the first memory and to the network interface; and
 - a second memory, communicatively coupled to the controller, for storing computer instructions for the controller to control the content server for:
 - receiving a request that includes a request for delivery of content information to the at least one networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of the content information comprising image information; and
 - determining, by at least one server within a network, based on the image delivery parameter and the image presentation parameter associated with the at least one networked device, an image format for the image information for delivery of the image information to the at least one networked device and for presentation of the image information at the at least one networked device, the image delivery

parameter and the image presentation parameter associated with the networked device being contained in the session information.

14. The system of Claim 13, wherein the determining is performed with a proxy server that is separate and remote across the network from the content server.

15. The system of Claim 13, wherein the first memory comprises
a first database for storing records containing image delivery parameters and image presentation parameters associated with the at least one networked device, and
a second database for storing at least one image record, the at least one image record containing;

an image header for at least identifying an image and identifying at least one available image format in the image record, and

image information formatted in the at least one available image format.

16. The system of Claim 13, wherein the controller uses Application Programming Interface (API) calls to request at least the determination, based on at least one of an image delivery parameter and an image presentation parameter associated with the at least one networked device, an image format for the image information.

17. The system of Claim 16, further comprising an image server, responsive to the API calls, for serving up the image information in the determined image format.

18. The system of Claim 16, further comprising an image proxy engine, responsive to the API calls, for determining, based on at least one of an image delivery parameter and an image presentation parameter associated with the at least one networked device, the image format for the image information.

19. The system of Claim 13, wherein the determined image format is selected from a set of image formats including binary bitmap and vector based graphics.

20. The system of Claim 13, wherein the determined image format is selected from a set of image formats including JPEG, GIF, TIFF, JPEG 2000, VML, and WAVELETS.

21. The system of Claim 13, wherein the image delivery parameter corresponds to at least one network communication link type of the following link types: T-1, DSL, CABLE, POTS, CELLULAR, PAGING, SATELLITE, RADIO, and WIRELESS.

22. The system of Claim 13, wherein the image presentation parameter corresponds to at least one presentation platform type of the following types: PC-like, Mac-like, Desktop Workstation, Laptop, Handheld, Notebook, Palm-like, Cellular Phone, Cordless Phone, Two-Way Pager, and PDA.

IX. EVIDENCE APPENDIX

NONE

X. RELATED PROCEEDINGS APPENDIX

NONE